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10/534,911	05/13/2005	Jan Thomas Haines	056222-5075	6725

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EXAMINER
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KAROL, JODY LYNN

ART UNIT	PAPER NUMBER
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1609

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/534,911

Applicant(s)

HAINES, JAN THOMAS

Examiner

Jody L. Karol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 1/6/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 11-12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/13/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This application is a 371 of PCT/GB03/04838 International Filing Date: 11/10/2003, which claims priority to GB 0226490.1. Claims 2-5 and 7-10 have been amended, and claims 10-12 have been added as per applicant's preliminary amendment dated 1/6/2006. Accordingly, claims 1-12 are pending and examined on the merits herein.

#### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) filed on 5/13/2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered.

#### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on Application No. 0226490.1 filed in the United Kingdom on 11/14/2002.

#### ***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: Cinnamon Flavor Compositions Comprising Cinnamic Alcohol and Eugenol.

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4. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

#### ***Claim Objections***

5. Claims 11-12 are objected to because of the following informalities: Claim 11 is a dependent claim that refers to dependent claim 4 and is separated by other claims

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that do not depend on claim 4. Claim 12 is objected to for being dependent on an objected base claim. Appropriate correction is required.

A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-6, 8, and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 11 indicate that the ratio of cinnamic alcohol to eugenol is **at least** 0.5:1 and 1:1 respectively. Claims 4 and 12 indicates that the weight ratio of cinnamic alcohol to eugenol is **not more** than 3:1 and 2:1 respectively. In this context, the terms **at least** and **not more** are not clear. The ratios are confusing in this context since ratios define upper and lower limits, and by adding a term such "at least" before a ratio confuses the ratio.

For the purposes of examination, claims 3-4 and 11-12 will be interpreted as specifying a range of weight ratios, where the upper and lower limits not specifically stated in the claim are inferred from the weight ratio range given in the foregoing claims.

Claim 5 specifies that the composition also include capsicum **and/or** citrus oil. The term **and/or** is simultaneously inclusive and exclusive. The use of this term confuses the claim. The component is either present in the composition or not. For examination purposes, claim 5 will be interpreted as including capsicum **or** citrus oil. Claim 6 is rejected for being dependent on a rejected base claim.

Claim 8 specifies that the composition contains **no or substantially no** cinnamic aldehyde. The term **substantially no** makes it unclear if cinnamic aldehyde is present or not. If cinnamic aldehyde is present, the extent of its presence is also unclear. For examination purposes, claim 8 will be interpreted as containing **no** cinnamic aldehyde.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8-9, and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Bessette et al. (US 6,004,569).

Claim 1 is drawn to a flavor composition comprising cinnamic alcohol and eugenol, where the cinnamic alcohol and eugenol comprise at least 3% by weight of the

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total composition, and the weight ratio of cinnamic alcohol to eugenol is between 0.25:1 and 3.5:1. Claim 2 further limits the composition to comprise at least 5% by weight of cinnamic alcohol and eugenol together. Claim 3 is interpreted to comprise at least 5% by weight to cinnamic alcohol and eugenol, where the weight ratio of cinnamic alcohol to eugenol is a **range** between 0.5:1 and 3.5:1. Claim 4 is interpreted to further limit the weight ratio **range** of the composition of claim 3 to be between 0.5:1 and 3:1. Claims 11 and 12 are interpreted to further limit the weight ratio range to 1:1 to 3:1 and 1:1 to 2:1 respectively. Claim 8 contains all the limitations of claim 1, but is interpreted to exclude the presence of cinnamic aldehyde. Claim 9 is a consumer product that contains the flavor composition of claim 1. The term "comprising" in the instant claims is interpreted as broad and open-ended.

Bessette et al. teaches a pesticide composition comprising alpha-terpineol, eugenol, and cinnamic alcohol dissolved in acetone. The preferred weight percentages are as follows: 10-50% of alpha-terpineol, 10-50% of eugenol, and 20-35% of cinnamic alcohol. Bessette et al. also teaches that preferred blend has equal parts of the components (see column 5, lines 5-10 and claim 5). A 1:1 weight ratio of cinnamic alcohol to eugenol is taught since, for example, 20% of the weight of the composition could be eugenol and 20% could be cinnamic alcohol. Furthermore, from the percentages given, cinnamic alcohol and eugenol are clearly in the pesticide composition in greater than 5%. Therefore, all the limitations of claims 1-4 and 11-12 are met.

Furthermore, Bessette et al. discloses a sample 3B, where it is clear that the only components present in the composition are alpha-terpineol, eugenol, cinnamic alcohol, and acetone (see column 5, lines 5-6). Therefore all the limitations of claim 8 are met.

Bessette et al. teaches that sample 3B as described above, is a pesticide. A pesticide is useful as a consumer product for killing pests. Therefore, all the limitations of claim 9 are also met.

8. Claims 1-4 and 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Slangan et al. (US 3,917,870). Claims 1-4, 8-9, and 11 are discussed above. Claim 10 further limits claim 9 to a consumer product wherein the product is selected from oral care products, skin care products, and chewing gums.

Slangan et al. teaches a perfume formulation that comprises cinnamic alcohol in 60 parts by weight and eugenol in 20 parts by weight (see column 10, Example VIII). The overall weight percentage of the combination of cinnamic alcohol and eugenol compared to the rest of the composition is greater than 5%. This is determined by comparing the combined parts by weight of cinnamic alcohol and eugenol to the sum of the parts by weight of each component present in the composition. The weight ratio of cinnamic alcohol to eugenol is 3:1 in this particular composition. Cinnamic aldehyde is not listed as a component present in the composition. Additionally, a perfume formulation is considered a consumer product that is a skin care product. Therefore, all the limitations of claims 1-4 and 8-11 are met.



***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slangan et al. (US 3,917,870) as applied to claims 1-4 and 8-11 above in view of the online book "Common Fragrance and Flavor Materials" by Bauer et al., published on the web on 11/5/2001.

Claim 5 is directed to the composition of claim 1, wherein the composition is interpreted to additionally include capsicum **or** citrus oil. Claim 6 further limits claim 5 to including citrus oil that comprises lime oil. Claim 7 is directed to the composition of claim 1, wherein the composition additionally includes on or more of the following components: benzyl formate, methyl cinnamate, benzoin, ethyl phenyl glycidate, ginger oil, cinnamyl acetate, and methyl heptenone.

Slangan et al. is important for teaching the composition of claim 1 as described above. However, Slangan et al. does not teach a composition wherein any of the following additional components of claims 5-7 are included: capsicum, citrus oil, benzyl formate, methyl cinnamate, benzoin, ethyl phenyl glycidate, ginger oil, cinnamyl acetate, and methyl heptenone.

Bauer et al. discloses essential oils, such as citrus peel oils, that are frequently used in the production of flavor or fragrance compositions to impart a desired

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characteristic or taste (see page 169). For example, citrus oils, and in particular lime oil are added to flavor or fragrance compositions to impart a citrus or lime flavor or aroma (see pages 185-188). Ginger oil is added to flavor or fragrance materials to impart a persistent ginger odor that lacks the pungency of actual ginger (see page 198).

Bauer et al. also discloses other flavor and fragrance materials that are not considered essential oils, such as methyl cinnamate or cinnamyl acetate. Methyl cinnamyl acetate is added to fragrance compositions to impart a fruity, sweet-balsamic odor (see page 121). Cinnamyl acetate is used to impart cinnamon-fruity effects (see pages 118-119).

Fragrance and flavor components such as lime oil, ginger oil, and methyl cinnamate are well known components in the art, with well-known characteristics and flavors. Therefore, it would be obvious to one of ordinary skill in the art, at the time the invention was made, to include fragrance or flavor component as taught in Bauer et al. to impart an additional desired characteristic or aroma on the fragrance composition of Slangan et al.

The result-effective adjustment in conventional working parameters (e.g., determining an appropriate amount of the components within the composition) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

### ***Conclusion***

No claims are allowed.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jody L. Karol whose telephone number is (571) 274-3283. The examiner can normally be reached on 8:30 am - 5:00 pm Mon-Fri EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Stucker can be reached on (571) 272-0911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

JLK



**MICHAEL MELLER**  
**PRIMARY EXAMINER**